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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88728723
Applicant	Walrus Rodeo LLC
Applied for Mark	GOLDN PAYDIRT
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Submission	Applicant's brief
Attachments	20211011_Goldn_Paydirt_Appeal.pdf(134099 bytes)
Appealed class	Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are appealed, namely: Gold; Gold bullion; Gold ore; Gold and its alloys; Gold, unworked or semi-worked; Gold, unwrought or beaten; Palladium; Palladium and its alloys; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Silver; Silver bullion; Silver ore; Alloys of precious metal; Platinum; Unworked or semi-worked gold
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Walrus Rodel LLC

Serial No: 88728723

EX Parte Appeal

October 11, 2021

The Trademark Examining Attorney refused registration under Section 2(e)(1) Refusal – Merely Descriptive

INTRODUCTION

Applicant is planning a panning novelty item. Where the consuming public is taught among other things, how to pan for riches. Applicant has requested the trademark registration of GOLDN PAYDIRT as a suggestive trademark to put in the mind of the consumer that the consumer will be rich by buying the Applicant's products. Applicant asks the Board to view this as a lottery. Applicant does not believe that the Board should take the trademark literally. The dirt does not pay one any money, the dirt is not golden, the dirt is not an ATM, the dirt would not even be considered by others to be dirt, instead it could be considered possibly sand. Thus, the Applicant asks the Board to view the Mark as a figurative and thus suggestive indicator of the rewards offered to the consumer.

LEGAL STANDARD

The Examiner has clung to narrow definitions of the Applicant's products to make it "merely descriptive." The Examiner has changed the "merely descriptive" standard to "descriptive in any way" standard. The Applicant believes this to be in error. Section 2(e)(1) of the Trademark Act

prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive of them,” unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).² But, [a] term is “merely descriptive” within the meaning of § 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). A term “need not immediately convey an idea of each and every specific feature of the goods [or services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods [or services].” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

Instead of “merely descriptive”; the Applicant’s Mark is figurative and thus suggestive. Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. See *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). Therefore, a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable. As a reminder, If, after conducting independent research, it is unclear to the examining attorney whether a term in a mark has meaning in the relevant industry, the examining attorney must make an inquiry of the applicant, pursuant to 37 C.F.R. §2.61(b).

ARGUMENTS AND ANALYSIS

GOLDN PAYDIRT only vaguely describes that all the dirt is gold and that the dirt will pay. The Applicant does not embrace that strange and yet vague description. Instead, Applicant's Mark suggests a winner, specifically a lucky winner. Buy the Applicant's product because the consumer will hit a JACK POT or a GOLDN PAYDIRT. The Applicant wants the consuming public to imagine a GOLDN PAYDIRT. Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. See *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described).

Applicant, also, believes that the Mark is incongruent. Dirt does not pay, and except in maybe the alchemist's world, dirt is not golden, and cannot be gold. Incongruity is a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase "theater-in-

the-round" created an incongruity because applicant's tennis facilities are not at all analogous to those used in a "theater-in-the-round").

If there is any doubt that the Mark is suggestive; the doubt must be resolved in favor of Applicant. There is "a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment." **Any doubt is to be resolved in favor of the applicant.**

The wording GOLDN PAYDIRT does not immediately describe any specific characteristic or feature of Applicant's services with any actual degree of particularity. At worst, GOLDN PAYDIRT is highly suggestive of the goal of Applicant's services, which provide a novelty game and learning mechanism for people allowing them to sift through sand in hopes of finding a reward, but falls short of being merely descriptive as articulated by the Examining Attorney. See *In re Armadahealth, LLC*, Serial Nos. 86713902; 86802355 (June 28, 2017). GOLDN PAYDIRT is the prize available for the winner of the novelty game, similar to using the word JACKPOT for a lottery.

Applicant would like to point out that the U.S. Trademark Office has allowed countless JACKPOT trademarks. Each JACKPOT trademark indicates or suggests to the consumer that they are winners.

Examining Attorney has not articulated one significant attribute of the actual goods, that makes the Applicant's Mark descriptive. A term need not immediately convey an idea of each and every specific feature of the services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or feature of them. See *In re Gyulay*, 3 USPQ2d at 1010; *In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 (TTAB 2015). There is no significant

feature of the Applicant's goods where the dirt is golden or where the dirt pays. Again, the dirt is not an ATM.

NON-DESCRIPTIVE WORDS AND THEIR DEFINITIONS

Examiner has admittedly failed to consider the meanings of the Mark that are non-descriptive in relation to the goods offered to consumers. Paydirt contains two definitions:

- 1) Earth which contains profitable quantities of ore
- 2) (figuratively) A profitable area or period; success.

Applicant means to have the word "paydirt" apply to the figurative definition of (2). Examiner seems to have found the Applicant's website but is unable to determine the figurative nature of the website. The entire point of Applicant's goods and services is to suggest to the consumer that it has struck a jackpot or in this case a golden paydirt.

Again, Applicant rejects the Examiner's determination that anything is golden in color. Applicant is not an alchemist and cannot make dirt into gold. If there is any gold in Applicant's product it is too small for the eye to see and can only be found by panning it out. Applicant does not sell gold dirt. This assumption is unfounded, and unimaginable.

Applicant realizes that Examiner might be confused by the hyperbole in some of the screen shots Examiner offers as record. Specifically, Applicant points to the 3 ounces of Gold given away by others. First, these appear to be gold nuggets, valued at nearly \$2000 per ounce. These nuggets are definitely bright in color and are the size of a finger. These nuggets would be easily viewable in a bag. That means that a bag would contain at \$6000 of easily viewable gold nuggets. Thus the consumer would just go from bag to bag looking for the bright color gold and buy \$6000 worth of gold for \$40. Again, the products the Examiner points out are novelty games to learn to

pan for gold. It is highly suggestive that they contain paydirt, especially goldn paydirt. Or that by buying the product one will find a “goldrush.” Furthermore, Examiners documented screenshots contain stories of legends and get rich quick schemes. One is from 1902. Again, highly suggestive that one will find a goldrush.

One example Examiner proffers, says it contains “Black Sand Magnets” and equates that with “Gold Magnet.” It further states it contains “Black Sand Concentrates” which it equates to “Black Sand Gold.” Applicant’s point is that Examiner has proffered extreme examples of hyperbole and is treating this extreme hyperbole as the standard.

Examiner gives as reference GOLDRUSH paydirt. Applicant is unaware of why Examiner would do so, since there is no reason to believe that Examiner would not accept the Mark GOLDRUSH in International Class 014; as it has already been for similar goods. See Registration 3221036. Furthermore, in Examiner’s examples, Examiner defeats the Examiner’s own arguments that the dirt is golden. Examiner shows through pictures that the gold is undetectable by the human eye and therefore “kits” must be purchased to extract the gold or other precious metals. Again, Examiner’s entire argument is built upon the dirt being golden, yet Examiner shows that is not the case in the 95 attachments. Therefore, Examiner shows that the consumer must use a lot of imagination to get to the Examiner’s conclusion.

Examiner’s attachments include places to buy “jewelry grade gold”, testimonials on how the “concentrate bag” wets the consumers appetite for actual gold prospecting, gemstone tumbling mix, buying goal vials, books on how to gold pan, places to buy gold paydirt¹, flow pans, turbo

¹ Applicant would like to point out that these are actually gold flakes, they are real natural gold flakes for sale. No imagination is needed to ascertain the product.

pans, gallons of ore, gems, diamonds, XRF analysis labs, kimberlite spheres, geologist rock breaking, zeroing in on zinc, copper deposits, uranium deposits, and countless others. Even many of the attachments use the word paydirt in a suggestive way. Suggesting a prize. Once again, the word paydirt cannot be taken literally. The dirt does not pay. It is not an ATM.

CONCLUSION

Applicant believes that the Examiner has embraced definitions that cannot be taken literally and should instead realize that the Applicant's use of the Mark is figurative and thus suggestive. Applicant's use and future use of the Mark require an imagination. Applicant is using the word paydirt to suggest a prize. The dirt if any does not pay and the product is not golden.

Applicant requests that the Board allow the registration of Applicant's Mark for international class 014.

Respectfully,

s/Nathan Brown
Attorney of Record